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SERIAL NUMBER	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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08/116,873 09/03/93 SUTCLIFFE

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EXAMINER  
SCHEINER, L

18N1/0711

ART UNIT PAPER NUMBER

DRESSLER, GOLDSMITH,  
SHORE & MILNAMOW, LTD.  
TWO PRUDENTIAL PLAZA - SUITE 4700  
180 NORTH STETSON AVENUE  
CHICAGO, IL 60601

1813

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DATE MAILED: 07/11/95

This is a communication from the examiner in charge of your application.  
COMMISSIONER OF PATENTS AND TRADEMARKS

☒ This application has been examined ☒ Responsive to communication filed on 4/14/95 ☒ This action is made final.

A shortened statutory period for response to this action is set to expire 3 month(s), \_\_\_\_\_ days from the date of this letter.  
Failure to respond within the period for response will cause the application to become abandoned. 35 U.S.C. 133

Part I THE FOLLOWING ATTACHMENT(S) ARE PART OF THIS ACTION:

- |   |   |
|---|---|
| 1. <input type="checkbox"/> Notice of References Cited by Examiner, PTO-892.        | 2. <input type="checkbox"/> Notice of Draftsman's Patent Drawing Review, PTO-948. |
| 3. <input checked="" type="checkbox"/> Notice of Art Cited by Applicant, PTO-1449.  | 4. <input type="checkbox"/> Notice of Informal Patent Application, PTO-152.       |
| 5. <input type="checkbox"/> Information on How to Effect Drawing Changes, PTO-1474. | 6. <input type="checkbox"/> _____   |

Part II SUMMARY OF ACTION

1. ☒ Claims 26-33 are pending in the application.

Of the above, claims \_\_\_\_\_ are withdrawn from consideration.

2. ☐ Claims \_\_\_\_\_ have been cancelled.

3. ☒ Claims 31 is are allowed.

4. ☒ Claims 26-30, 32 & 33 are rejected.

5. ☐ Claims \_\_\_\_\_ are objected to.

6. ☐ Claims \_\_\_\_\_ are subject to restriction or election requirement.

7. ☒ This application has been filed with informal drawings under 37 C.F.R. 1.85 which are acceptable for examination purposes.

8. ☐ Formal drawings are required in response to this Office action.

9. ☐ The corrected or substitute drawings have been received on \_\_\_\_\_. Under 37 C.F.R. 1.84 these drawings are ☐ acceptable; ☐ not acceptable (see explanation or Notice of Draftsman's Patent Drawing Review, PTO-948).

10. ☐ The proposed additional or substitute sheet(s) of drawings, filed on \_\_\_\_\_, has (have) been ☐ approved by the examiner; ☐ disapproved by the examiner (see explanation).

11. ☐ The proposed drawing correction, filed \_\_\_\_\_, has been ☐ approved; ☐ disapproved (see explanation).

12. ☐ Acknowledgement is made of the claim for priority under 35 U.S.C. 119. The certified copy has ☐ been received ☐ not been received ☐ been filed in parent application, serial no. \_\_\_\_\_; filed on \_\_\_\_\_.

13. ☐ Since this application appears to be in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under Ex parte Quayle, 1935 C.D. 11; 453 O.G. 213.

14. ☐ Other

EXAMINER'S ACTION

Applicant's election without traverse of claims 26-33 (Group II) in Paper No. 7 is acknowledged.

Claims 26-30, 32, and 33 are vague and indefinite since the extent of subject matter to which the exclusionary right granted by patent is intended to apply cannot be determined and for further reasons of record.

The following is a quotation of the first paragraph of 35 U.S.C. § 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 26-30, 32, and 33 are rejected under 35 U.S.C. § 112, first paragraph, as the disclosure is enabling only for claims limited to the DNA as represented by instant Figures. See M.P.E.P. §§ 706.03(n) and 706.03(z) for reasons of record.

Claims 26-30, 32, and 33 are rejected under 35 U.S.C. § 112, first paragraph, for the reasons set forth in the objection to the specification.

Applicant's well thought out and nicely presented arguments are acknowledged and appreciated, however, they are not persuasive since infringement and patent validity analyses consider the same issue of whether a new product, or patent claim differs from or is unobvious over a prior art product, or patent claim. That is, it is clearly acknowledged that no prior art has been applied in the instant case, however, due to the extremely broad scope and indefinite nature of the claims it would be

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virtually impossible for one to make decisions with regard to possible infringement issues. That is, a procedure by which a possible infringer could determine if he was in fact infringing appears to be extremely burdensome. Essentially, applicant claims all possible isolated DNA having a length which falls within a range that is complementary to cytoplasmic mammalian RNA that is present in brain, but not liver, kidney, gut, lung, heart, or skeletal muscle of the same species, wherein the messenger is capable of encoding a neuroactive proteinoid. As such, the examiner contends that the scope of the claims is wholly indeterminate. It reads on so many DNA molecules that one cannot adequately determine its scope. The decision in *Tanksley* specifically sets forth that the metes and bounds of the claims must be definite in order that a member of the public can determine the extent of the subject matter to which the exclusionary right granted by patent is intended to apply. It has been indicated in several prior decisions that claims may be too indefinite to be examined with respect to the prior art. It is clear that determining anticipation in the present case would involve precisely the type of "speculation" proscribed by the decision in *In re Steele*. That is, in *In re Steele*, 305 F.2d 859, 134 USPQ 292 (CCPA 1962), the court pointed out that before the claimed subject matter could properly be compared to the prior art, it was essential to know what in fact the claims did cover.

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**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 C.F.R. § 1.136(a).

A SHORTENED STATUTORY PERIOD FOR RESPONSE TO THIS FINAL ACTION IS SET TO EXPIRE THREE MONTHS FROM THE DATE OF THIS ACTION. IN THE EVENT A FIRST RESPONSE IS FILED WITHIN TWO MONTHS OF THE MAILING DATE OF THIS FINAL ACTION AND THE ADVISORY ACTION IS NOT MAILED UNTIL AFTER THE END OF THE THREE-MONTH SHORTENED STATUTORY PERIOD, THEN THE SHORTENED STATUTORY PERIOD WILL EXPIRE ON THE DATE THE ADVISORY ACTION IS MAILED, AND ANY EXTENSION FEE PURSUANT TO 37 C.F.R. § 1.136(a) WILL BE CALCULATED FROM THE MAILING DATE OF THE ADVISORY ACTION. IN NO EVENT WILL THE STATUTORY PERIOD FOR RESPONSE EXPIRE LATER THAN SIX MONTHS FROM THE DATE OF THIS FINAL ACTION.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Laurie Scheiner whose telephone number is (703) 308-1122.

Papers related to this application may be submitted to Group 180 by facsimile transmission. Papers should be faxed to Group 180 via the PTO Fax Center located in Crystal Mall 1. The faxing of such papers must conform with the notice published in the Official Gazette, 1096 OG 30 (November 15, 1989). The CM 1 Fax Center number is (703) 308-4227.

L.S.  
Laurie Scheiner/LAS  
July 9, 1995

  
**MARY E. MOSHER**  
**PRIMARY EXAMINER**  
**GROUP 1800**